

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-17 are now pending, wherein claims 15-17 have been added. New claims 15-17 are similar to original claims 1, 3 and 4, and support for these new claims can be found at least in original claims 1, 3 and 4.

Applicants note with appreciation the Examiner's consideration of the documents cited in the Information Disclosure Statements filed on August 23 and August 28, 2001.

⑨ Applicants note that the Office Action does not include an acknowledgment of Applicants' claim for domestic priority to U.S. Provisional Application No. 60/210,919 filed June 12, 2000. Applicants also note that the Office Action does not include an acknowledgment of Applicants' claim for foreign priority to European Patent Application No. 00610059-8 filed June 9, 2000, or an acknowledgment that the Patent Office has received the certified copy of the European priority document filed on August 23, 2001. Accordingly, Applicants respectfully request that the next Office Action acknowledges Applicants' claims for priority, and that the certified copy of the European priority document has been received.

In the second paragraph of the Office Action claims 1-3, 5, 6, 8-10, 12 and 13 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,694,451 to Arinell ("Arinell"). This ground of rejection is respectfully traversed.

Arinell does not anticipate Applicants' claim 1 because Arinell does not disclose all of the elements of Applicants' claim 1. For example, Arinell does not disclose the step of "generating a support request at said mobile unit" as recited in Applicants' claim 1.

Arinell discloses a method and arrangement for performance monitoring in a telecommunications network. Information regarding the performance of the telecommunications network is performed on the subscriber side. Subscriber terminals comprise sensing elements which sense selected activities of terminals, and store the sensed information. The stored information is transferred to the public side of the network during call set-up, call transfer, or call disconnecting. (Arinell at col. 3, lines 11-17).

The Office Action acknowledges that Arinell does not explicitly disclose the step of "generating a support request at said mobile terminal." Nevertheless, the Office Action asserts that this step is inherent in Arinell. M.P.E.P. § 2112 citing *In re Robertson* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), states that

[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

The Office Action asserts that the generating step of Applicants' claim 1 is inherent in the disclosure of Arinell because "the terminal owner is experiencing problems." However, Arinell discloses that the stored sensed information is provided to the public side of the network during call set-up, call transfer, or call disconnecting. Arinell does not indicate that such information should be provided to public side of the network based on the

terminal owner experiencing problems. Instead, it appears that Arinell automatically reports the stored sensed information during call set-up, call transfer or call disconnecting regardless of whether the terminal owner is experiencing problems. Accordingly, it is respectfully submitted that Arinell does not "make clear that [generating a support request at said mobile unit] is necessarily present" in Arinell, and hence, such a step is not inherent in Arinell.

Because Arinell does not disclose all of the elements of Applicants' claim 1, Arinell cannot anticipate Applicants' claim 1. Claims 2, 3, 5 and 6 variously depend from claim 1, and are, therefore, patentably distinguishable over Arinell for at least those reasons stated above with regard to claim 1.

Claim 8 recites a system with similar elements to those discussed above with regard to Applicants' claim 1. Accordingly, claim 8 is not anticipated by Arinell for similar reasons to those discussed above with regard to Applicants' claim 1. Claims 9, 10, 12 and 13 are dependent upon claim 8, and are therefore, not anticipated by Arinell for at least those reasons stated above with regard to claim 8.

For at least those reasons stated above, it is respectfully requested that the rejections of claims 1-3, 5, 6, 8-10, 12 and 13 as allegedly being anticipated by Arinell be withdrawn.

In the fourth paragraph of the Office Action claims 4 and 11 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of the combination of Arinell and U.S. Patent No. 6,393,274 to Peltonen ("Peltonen"). This ground of rejection is respectfully traversed.

Claims 4 and 11 respectively depend from claims 1 and 8. As discussed above with regard to claims 1 and 8, Arinell does not disclose all of the elements of these claims. It is respectfully submitted that Peltonen does not remedy the above-identified deficiencies of Arinell with respect to claims 1 and 8. Accordingly, the combination of Arinell and Peltonen cannot render claims 1 and 8 unpatentable. Hence, claims 4 and 11 are patentably distinguishable over the combination of Arinell and Peltonen for at least those reasons stated above with regard to claims 1 and 8.

For at least those reasons stated above, it is respectfully requested that the rejection of claims 4 and 11 as allegedly being obvious in view of the combination of Arinell and Peltonen be withdrawn.

In the fifth paragraph of the Office Action claims 7 and 14 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of the combination of Arinell and U.S. Patent Application Publication No. US 2002/0099846 A1 to Hicks ("Hicks"). This ground of rejection is respectfully traversed.

6 The combination of Arinell and Hicks does not render Applicants' claims 7 and 14 unpatentable because Hicks is not prior art with respect to the present application. The present application claims priority from a European Application filed on June 9, 2000 and a U.S. Provisional Application filed on June 12, 2000. Hicks is an application which was filed on January 21, 2001. Because the filing date of Hicks is after the priority dates claimed by the Applicants, it is respectfully submitted that Hicks is not prior art with respect to the present application.

To reject Applicants' claims 7 and 14, the Office Action acknowledges that Arinell does not disclose or suggest what is recited in these claims, but instead, relies upon Hicks. Because the Office Action acknowledges that Arinell does not disclose or suggest the elements of claims 7 and 14, and because Hicks is not prior art with respect to the present application, the rejection of claims 7 and 14 as allegedly being obvious in view of the combination of Arinell and Hicks is improper, and should be withdrawn.

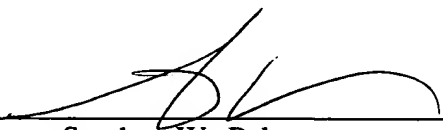
New claim 15 is patentably distinguishable over the rejections of record because new claim 15 recites the step of "generating a support request at said mobile unit", which as discussed above in connection with claim 1, is not disclosed or suggested by the rejections of record. Claim 16 and 17 are patentably distinguishable over the rejections of record at least by virtue of their dependency upon claim 15.

All outstanding objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice to this effect is earnestly solicited. If there are any questions regarding this response, or the application in general, the Examiner is encouraged to contact the undersigned at 703-838-6578.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: 
Stephen W. Palan
Registration No. 43,420

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620